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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,862	04/22/1999	HIROYUKI KURIYAMA	500.37156XOO	2908

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EXAMINER	
BEX, PATRICIA K	

ART UNIT	PAPER NUMBER
1743	23

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-23

Office Action Summary	Application No.	Applicant(s)	
	09/284,862	KURIYAMA ET AL.	
	Examiner	Art Unit	
	P. Kathryn Bex	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 September 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-7,10 and 12-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-7,10 and 12-17* is/are rejected.

7)☒ Claim(s) *3* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *20* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Any rejection and/or objection not repeated herein has been withdrawn.

Information Disclosure Statement

2. The information disclosure statement filed November 06, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Objections

3. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim 1. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 now recites "a re-examining buffer". Furthermore, the use of two separate re-examining buffers is not supported within the instant specification. Clarification is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3, 5-6, 10, 13-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specimen rack conveying means 20 comprising two separate conveying paths 21, 22 for conveying the specimen racks in different directions (see page 10, 1st full paragraph), does not reasonably provide enablement for the specimen conveying part for "reciprocally" conveying the specimen rack. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The instant claims disclose the specimen conveying part for "reciprocally" conveying the specimen rack, however, this broad limitation allows for a single conveyor which provides reversible (e.g. reciprocal) movement. Such an embodiment is not supported within the instant specification. The specification supports either *two separate* conveying paths 21, 22 for conveying the specimen racks in different directions (see page 10, 1st full paragraph, Fig. 5) or a *single* conveyor 20 which supplied to the different analyzing parts in a single direction (see page 19, line 19-page 22, line 22, Fig. 7). (Emphasis Added).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the identification parts" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 3, 5-7, 10, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanamori (USP 5,232,081) in view of Ishibashi (5,087,423).

Kanamori teaches an modular analyzer system comprising a specimen rack 18, a specimen introducing part 10, a specimen rack conveying parts 12a, 12b, a storage part for storing the specimen 14 and three different analyzers 21, 22, 24. The introducing part, the storage part Y4 and the analyzers are independent of each other and coupled to one another by means of the specimen rack conveying part in the rear of the analyzers (column 6, line 37-column 7, line 19, Fig. 7), the analyzers each comprising sampling means. Kanamori teaches a reexamining buffer 60 for temporarily holding a specimen after analysis is complete by analyzer

21. The reexamining buffer is located between the specimen introducing part 10 and the storage part for storing the specimen 14. Given the teaching of the modular system of Kanamori, it would have been obvious to one of ordinary skill that the independent units are equal in height and depth, so that it is possible to avoid the high cost that would arise from special ordering an entire analyzing system.

Kanamori does not disclose the use of a specimen rack conveying part for reciprocally conveying the specimen rack to at least two analyzers. Ishibashi does teach the use of a specimen rack conveying means comprising separate conveying paths 76a, 79a, 80 and 84 for conveying the specimen racks in different directions (column 8 line 43- column 9, lines 36, Fig. 5). Additionally, Ishibashi teaches that each analyzer includes a take-in buffer 77a, 77b and a specimen rack discharge part 81, 82 (column 3, line 66- column 4, line 3).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the analyzer system of Kanamori a specimen rack conveying means comprising separate conveying paths in order to quickly and easily distribute the samples to another analyzer in an effective manner if necessary.

With respect to claim 7, it has been held that matters relating to ornamentation, (i.e. slits) only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art). See MPEP 2144.04 (I) and *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

With respect to the specific heights and depths of the units recited in claims 5 and 12, one of ordinary skill in the art would have found it obvious to have provided the modular units of Wakatake with a particular height and depth, in order to optimize the ability of the average

observer to work at the units. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3, 5-6, 10, 12-17 have been considered but are moot in view of the new ground(s) of rejection. See above Office Action.

Conclusion

11. No claims allowed.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to

3:30 pm EST. The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Kathryn Bex

P. Kathryn Bex
Patent Examiner
AU 1743
June 2, 2003

Jill Warden
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